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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,407	02/12/2004	Miguel-Angel Garcia-Martin	P17982	5790

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ERICSSON INC.
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M/S EVR 1-C-11
PLANO, TX 75024

EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2614

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10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/777,407	Applicant(s) GARCIA-MARTIN ET AL.	
	Examiner Lisa Hashem	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9-16-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 4-14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on any other multiple dependent claim. See MPEP § 608.01(n).
2. Claims 3, 5, and 15-17 objected to because of the following informalities: The acronym 'IP' is not defined in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 6, 11, and 14 recite the limitation "the circuit switched session". There is insufficient antecedent basis for this limitation in these claims.
5. Claim 6 recites the limitation "the establishment". There is insufficient antecedent basis for this limitation in the claim.
6. Claim 9 recites the limitation "the server". There is insufficient antecedent basis for this limitation in the claim. It is not clear if the 'server' refers to the 'SIP server' or the 'gateway server'.
7. Claim 11 recites the limitation "the SIP signalling session". There is insufficient antecedent basis for this limitation in the claim.
8. Claims 8, 9, 11, 12, and 17 recite the limitation "the gateway". There is insufficient antecedent basis for this limitation in these claims.

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9. Claim 13 recites the limitation "the radio access network". There is insufficient antecedent basis for this limitation in the claim.

10. Claim 16 recites the limitation "the setting up of" and "the circuit switched domain". There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,996,087 by Ejzak.

Regarding claim 1, Ejzak discloses a method of setting up a session between peer user terminals (Fig. 1, 111; col. 2, lines 31-33; col. 3, lines 37-43; col. 4, lines 26-43) of a communication system (Fig. 1), said session extending at least in part across a circuit switched access network (i.e. PSTN; Fig. 1, 161), the method comprising transporting signalling to initiate said session between at least one of the peer user terminals and said communication system via an IP based packet switched access network using a call control protocol (i.e. SIP) which is also used for setting up end-to-end packet switched sessions, and subsequently establishing said session based upon said signalling (col. 4, lines 26-40; col. 5, lines 35-52; col. 8, line 57 – col. 9, line 18).

Regarding claim 2, a method according to claim 1, wherein Ejzak discloses said session requires one or more conversational bearers (col. 5, line 14 – col. 6, line 7; col. 8, line 57 – col. 9, line 18).

Regarding claim 3, a method according to claim 2, wherein Ejzak discloses said session comprises non-conversational bearers established over said IP based packet switched network (col. 3, lines 19-23; col. 7, lines 27-35; col. 8, lines 8-25).

Regarding claim 4, a method according to any one of the preceding claims, Ejzak discloses said at least one of the peer user terminals being a dual mode mobile terminal capable of using both said packet switched and circuit switched access networks (col. 3, lines 37-43; col. 4, lines 26-33; col. 5, lines 41-52).

Regarding claim 5, a method according to any one of the preceding claims, wherein Ejzak discloses the signalling which initiates said session is Session Initiation Protocol, SIP, signalling exchanged between said at least one of the peer user terminals and a SIP server (i.e. CSCF; Fig. 1, 143; col. 4, lines 34-40 and lines 46-50) of an IP Multimedia Core Network Subsystem (IMS) (Fig. 1, 141; (IMS)) (col. 5, lines 36-52; col. 8, line 57 – col. 9, line 11).

Regarding claim 6, a method according to claim 5, wherein Ejzak discloses said SIP server notifies a gateway server (i.e. MGW -> media gateway; Fig. 1, 148) when it receives a session initiation request which requires the establishment of one or more conversational bearers, the gateway terminating the circuit switched session within the system (col. 3, lines 37-43; col. 4, lines 34-40; col. 5, lines 36-40).

Regarding claim 7, a method according to claim 6, wherein Ejzak discloses said SIP server and said gateway server are co-located (Fig. 1, 141) (col. 4, lines 10-24; col. 5, lines 6-13).

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Regarding claim 8, a method according to claim 6 or 7, wherein Ejzak discloses the gateway provides interworking between the circuit switched session on the one side, and the packet switched session on the other side (col. 2, lines 21-24; col. 5, line 9 – col. 6, line 7).

Regarding claim 9, a method according to claim 8, wherein Ejzak discloses following notification from the server, the gateway notifies said at least one of the peer user terminals of a callback telephone number, and the peer user terminal calls that number to establish a circuit switched session with the gateway (col. 3, line 60 – col. 5, line 52).

Regarding claim 10, a method according to claim 9, where Ejzak discloses the notification of the callback number is transferred via the SIP server (col. 3, line 60 – col. 5, line 52).

Regarding claim 11, a method according to claim 10, Ejzak discloses the gateway mapping the established circuit switched session to the SIP signalling session on the basis of the used callback number (col. 3, line 60 – col. 5, line 52).

Regarding claim 12, a method according to any one of claims 9 to 11, Ejzak discloses the gateway selecting the callback number from a pool of available callback numbers (col. 3, line 60 – col. 5, line 52).

Regarding claim 13, a method according to any one of claims 5 to 12, Ejzak discloses the SIP server determining that said session requires the establishment of a circuit switched session as a result of one or more of the following:

properties of the system known to the SIP server;

prior notification by said at least one of the peer user terminals;

information contained in the SIP signalling initiating the session;

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properties defined for the peer user terminal;

prior notification from a visited network in the case of a roaming user terminal;

and prior notification from the radio access network used by the peer user terminal (col. 4, line 44 – col. 5, line 52; col. 8, line 57 – col. 9, line 18).

Regarding claim 14, a method according to any one of the preceding claims, wherein Ejzak discloses said at least one of the peer user terminals maps the established circuit switched session to the signalling session over the packet switched domain, such that both session can be terminated together (col. 5, lines 14-46).

Regarding claim 15, Ejzak discloses user terminal (Fig. 1, 111; col. 3, lines 37-43) comprising means for using a circuit switched access network (i.e. PSTN; Fig. 1, 161) and means for using an IP based packet switched access network (Fig. 1, 131; col. 3, lines 52-59), and means for transferring signalling information, using a call control protocol (i.e. SIP) which is also used for setting up end-to-end packet switched sessions, over the packet switched network to initiate a session over the circuit switched network (col. 4, lines 26-40; col. 5, lines 35-52).

Regarding claim 16, Ejzak discloses a Session Initiation Protocol server (i.e. S-CSCF) for use in an IP Multimedia Core Network Subsystem (Fig. 1, 141; (IMS)) (col. 5, lines 41-52), the server comprising: means for receiving an INVITE request from a user terminal (i.e. mobile unit) (col. 8, lines 57-65), over an IP based packet switched domain (Fig. 1, 131; col. 3, lines 52-59), initiating a session; means for determining that said session requires the setting up of one or more conversational bearers in the circuit switched domain (i.e. PSTN; Fig. 1, 161); and means for causing said conversational bearer(s) to be established (col. 8, line 7 – col. 9, line 11).

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Regarding claim 17, Ejzak discloses a gateway server (i.e. MGW -> media gateway; Fig. 1, 148) for providing an interface between a circuit switched access network (i.e. PSTN; Fig. 1, 161) and a packet switched network (Fig. 1, 131; col. 3, lines 52-59) (col. 2, lines 21-24; col. 5, line 9 – col. 6, line 7), the gateway having an interface towards a Session Initiation Protocol server (i.e. CSCF; Fig. 1, 143; col. 4, lines 34-40 and lines 46-50) of an IP Multimedia Core Network Subsystem (Fig. 1, 141; (IMS)) (col. 5, lines 41-52), and means for receiving from the SIP server signalling instructing the establishment of a session over the circuit switched access network with a user terminal (Fig. 1, 111) (col. 3, lines 37-43; col. 4, lines 34-40; col. 5, lines 36-40).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

14. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

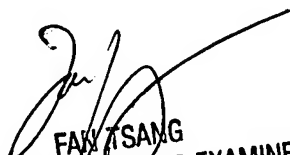
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh
September 20, 2007


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